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EXAMINER

LEROUX, ETIENNE PIERRE

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREJ GREGOV, ANDREW HARBICK,
GREG LINDEN, JONATHAN PAK, and JOSH PETERSEN

Appeal 2009-001176
Application 09/648,314
Technology Center 2100

Decided: April 20, 2010

Before JAMES D. THOMAS, JOSEPH L. DIXON, and STEPHEN C. SIU,
Administrative Patent Judges.

DIXON, *Administrative Patent Judge.*

DECISION ON APPEAL

I. STATEMENT OF THE CASE

The Appellants appeal under 35 U.S.C. § 134(a) from the Final Rejection of claims 15-16, 27-35, and 40-51. Claims 1-14, 17-26, and 36-39 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

The Invention

The invention at issue on appeal relates to a method for electronic marketing, in particular, product recommendations (Spec. 1).

The Illustrative Claim

Claim 15, an illustrative claim, reads as follows:

15. A method in a computing system for generating item recommendations for a user, comprising:

receiving requests from the user to display information about each of a plurality of items;

selecting as seed items the plurality of items that were displayed;

generating a list of recommended items each based on the selected seed items, wherein the generated list does not contain the selected seed items; and

displaying the generated list of recommended items to the user.

The References

The references relied upon by the Examiner as evidence in rejecting the claims on appeal are as follows:

Cluts

US 5,616,876

Apr. 1, 1997

Nakajima	US 5,897,650	Apr. 27, 1999
Bieganski	US 6,412,012 B1	June 25, 2002 (filed Dec. 23, 1998)
Chow	US 6,850,899 B1	Feb. 1, 2005 (filed Mar. 31, 2000)

The Rejections

The Examiner entered the following rejections which are before us for review:

Claims 15-16, 27-31, 45, and 48 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Bieganski.

Claims 32-34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bieganski and Cluts.

Claims 40-42, 46-47, and 49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bieganski and Chow.

Claims 43 and 50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bieganski, Chow, and Cluts.

Claims 35 and 51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bieganski and Nakajima.

Claim 44 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Bieganski, Chow, and Nakajima.

II. ISSUE

Has the Examiner erred in finding that Bieganski discloses “the generated list does not contain the selected seed items,” as recited in claim 15?

III. PRINCIPLES OF LAW

Anticipation

“[A]nticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim” *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) (citing *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1457 (Fed. Cir. 1984)). “[A]bsence from the reference of any claimed element negates anticipation.” *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986), *overruled on other grounds by Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*, 383 F.3d 1337 (Fed. Cir. 2004). In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005) (citation omitted).

Written Description Requirement under 35 U.S.C. § 112

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

35 U.S.C. § 112.

The written description requirement serves “to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific

subject matter later claimed by him; how the specification accomplishes this is not material.” *In re Wertheim*, 541 F.2d 257, 262 (CCPA 1976) (citations omitted).

IV. FINDINGS OF FACT

The following findings of fact (FFs) are supported by a preponderance of the evidence.

Bieganski

1. Bieganski discloses a method that utilizes a recommendation set 201, a shopping set 202, and a historical set 203 as inputs, and an item compatibility rules 204 working with compatibility modifier 200 to create a compatibility-modified product recommendation set/list 205 (col. 7, ll. 10-24, col. 10, ll. 37-63, Fig. 2 and 3).

Claimed Subject Matter

2. The Appellants pointed out that the written support of “wherein the generated list does not contain the selected seed items” as recited in independent claims can be found in the paragraph 5 of page 1 in the Specification (App. Br. 3-4).

Specification

3. The specification describes:

By the recommending additional products to a user in this manner, a web merchant can often sell a recommended product to a user that would not have otherwise purchased it, thereby generating additional sales and profits for the web merchant. Further, such recommendation services often have utility to the user, identifying items that would be useful to the user and of which the user was previously unaware.

(Spec. 1).

V. ANALYSIS

The Appellants have the opportunity on appeal to the Board of Patent Appeals and Interferences (BPAI) to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (citing *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

The Examiner sets forth a detailed explanation of a reasoned conclusion of unpatentability in the Examiner's Answer. Therefore, we look to the Appellants' Briefs to show error therein. *See In re Kahn*, 441 F.3d at 985-86 (citing *In re Rouffet*, 149 F.3d at 1355).

The Common Features in Claims

Independent claim 15, recites, *inter alia*, "the generated list does not contain the selected seed items." Independent claims 16 and 27 contain similar limitations.

35 U.S.C. § 102(e) rejection

With respect to independent claim 15, Appellants contend that the Examiner's § 102(e) rejection is improper because "Bieganski expressly teaches that the equated 'seed items' (i.e., shopping set) are included in the list of recommended items. Thus, Bieganski further fails to teach or suggest 'wherein the generated list does not contain the selected seed items' as recited in Claim 15." (Reply Br. 4).

We agree with the Appellants' contention. We find that Bieganski teaches that a recommendation set or optionally a shopping set and a history

set are received by the compatibility modifier and then the compatibility rules are applied to create final compatibility-modified recommendations (FF 1). Thus, we conclude that one of skilled in the art would recognize that the final compatibility-modified recommendations would include the seed items (i.e. the inputs). Because we agree with at least one of the Appellants' contentions, we find that the Examiner has not made a requisite showing of anticipation as required to disclose the invention as recited in claim 15 by Bieganski.

The rejection of dependent claims 40 and 45 contains the same deficiency. Appellants, thus, have demonstrated error in the Examiner's showing of anticipation of the subject matter of claims 15, 40, and 45.

Independent claims 16 and 27 contain similar limitations to those found in independent claim 15. Appellants present similar arguments as set forth with respect to independent claim 15 in response to the rejections of independent claims 16 and 27 (Reply Br. 5-6).

As we found above in our discussion with respect to independent claim 15, we similarly find that Appellants have demonstrated error in the Examiner's conclusion for anticipation of the subject matter of independent claims 16 and 27. The rejection of dependent claims 28-31 and 48 also contains the same deficiency. Hence, Appellants' argument persuades us that the Examiner erred in rejecting claims 16, 27-31, and 48.

We, therefore, cannot sustain the rejection of claims, 15-16, 27-31, 45, and 48 under 35 U.S.C. § 102 (e).

35 U.S.C. § 103(a) Rejection

We next consider the rejections of claims 32-35, 40-44, 46-47, 49, and 50-51 under 35 U.S.C. § 103(a).

The rejections of dependent claims 32-35, 40-44, 46-47, 49, and 50-51 contain the same deficiency as the rejection of claims 15, 16, and 27 under 35 U.S.C. § 102(e) as discussed above. The Examiner has not identified how the cited references remedy the noted deficiency. Therefore, we cannot sustain the obviousness rejections of dependent claims 32-35, 40-44, 46-47, 49, and 50-51.

VI. NEW GROUND OF REJECTION

35 U.S.C. § 112, first paragraph (written description)

We enter a new ground of rejection of claims 15-16, 27-35, and 40-51 under 35 U.S.C. § 112, first paragraph, because the claimed limitations “the generated list does not contain the selected seed items” recited in independent claims have not met the written description requirement under 35 U.S.C. § 112, first paragraph.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. *In re Kaslow*, 707 F.2d 1366, 1375 (Fed. Cir. 1983)(citations omitted). To locate the support of the argued limitations, we consult the Summary of Claimed Subject Matter in the Brief that the Appellants filed according to 37 C.F.R. § 41.37(c)(1)(v). The Appellants direct us to page one of the Specification (FF 2). However, we find that nothing in page one of the Specification supports the claimed limitations since the relied upon paragraph only mentions the “recommendation services” benefit of both the user and the web merchant (FF 3). Therefore, the Specification of the instant invention as originally filed fails

the written description requirement test and can not reasonably convey to the artisan that the Appellants had possession at that time of the later claimed subject matter.

Therefore, claims 15, 16, and 27 are unpatentable under 35 U.S.C. § 112, first paragraph, for lack of adequate written description of the invention. Claims 40-45 depend from claim 15; Claims 46-51 depend from claim 16; Claims 28-35 depend from claim 27. As such, claims 28-35, and 40-51 are likewise unpatentable for the same reasons.

VII. CONCLUSION

We conclude that the Appellants have shown that the Examiner erred in identifying that Bieganski discloses “the generated list does not contain the selected seed items,” as recited in claim 15.

VIII. DECISION

We reverse the rejection of claims 15-16, 27-31, 45, and 48 under 35 U.S.C. § 102 (e).

We reverse the rejections of claims 32-35, 40-44, 46-47, 49, and 50-51 under 35 U.S.C. § 103(a).

We enter a new ground rejection of claims 15-16, 27-35, and 40-51 under 35 U.S.C. § 112, first paragraph.

37 C.F.R. § 41.50(b) provides that “[a] new grounds of rejection pursuant to this paragraph shall not be considered final for judicial review.” Section 41.50(b) also provides that, within two months from the date of the decision, the appellant must exercise one of the following options to avoid termination of proceedings of the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner

(2) Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED- 37 C.F.R. § 41.50(b)

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